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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,722	07/22/2003	Takayuki Hattori	2927-0151P	5260

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER	
KOPEC, MARK T	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/623,722	HATTORI ET AL.	
	Examiner	Art Unit	
	Mark Kopec	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.

5)☒ Claim(s) 3 is/are allowed.

6)☒ Claim(s) 1,2,4-9 and 12 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's election with traverse of Group I in the reply filed on 11/07/05 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the examiner to examine both groups in the same application. This is not found persuasive because, as stated in the Restriction mailed 10/07/05, the searches required for these distinct groups are not coextensive.

The requirement is still deemed proper and is therefore made FINAL.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The references cited in the Search Report filed 11/25/03 have been considered, but will not be listed on any patent resulting from this application unless they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In order to conform to current U.S. practice, applicant should amend the instant language "selected from among a group of" to proper Markush language --selected from the group consisting of--.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 4-9 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Hilti et al (5,965,206) or JP 08-183866.

Hilti discloses a composition that comprises a thermoplastic or elastomeric polymeric substrate (A) and an antistatic mixture (B) in the form of contiguous fibers, which mixture comprises (b1) an organic polymeric material that is fibrous or forms fibers on mixing and is not soluble in the thermoplastic or elastomeric polymeric substrate (A); (b2) a polymer or copolymer capable of ion conduction that has blocks for complexing or solvating a salt of an inorganic or low-molecular-weight organic protonic acid (b3) and has a better compatibility with the organic polymer (b1) that is fibrous or forms fibers on mixing than with the polymeric organic substrate (A); and (b3) a salt of an inorganic or low-molecular-weight organic protonic acid such as NaClO.sub.4 or K P F.sub.6 that has been complexed or solvated in the polymer or copolymer (b2). The invention relates also to the antistatic mixture (B) as such, to its use in rendering polymers antistatic and to a process for the preparation of antistatic thermoplastic or elastomeric polymeric substrates (Abstract). As polymeric component (A), Hilti teaches styrene/EPDM terpolymer mixtures may be used (Col 4, lines 14-20). Also, it is possible to utilize the fibrous organic polymer (b2) in the form of granules or powder (Col 6, lines 27-30), and polyether amide block copolymer/inorganic salts are specifically disclosed (Col 7,

lines 1-5 and lines 55-60). The disclosed styrene/EPDM terpolymer mixtures meet the instant product-by-process limitation(s) regarding "by dynamically crosslinking". The reference specifically or inherently meets each of the claimed limitations.

JP 08-183866 discloses a thermoplastic elastomer sheet having antistatic properties (Abstract). The reference specifically discloses hydrogenated styrene butadiene rubber (para 0014), and polyether/ammonium salt ion conductive agent (para 0017-0020). The percentages of components overlaps with those claimed (para 0010 and 0012). The disclosed styrene/butadiene rubbers meet the instant product-by-process limitation(s) regarding "by dynamically crosslinking". The reference specifically or inherently meets each of the claimed limitations.

The references are anticipatory.

In the event that any minor modifications are necessary to meet the claimed limitations, such as selection of "dynamic crosslinking", such modifications are well within the purview of the skilled artisan. See, for example, Okuyama (6,184,295), which disclose such as a preferred method of making hydrogenated styrene thermoplastic elastomer.

In view of the foregoing, the above claims have failed to patentably distinguish over the applied art.

Claim 3 is allowed. The prior art of record does not disclose or fairly suggest the addition of carbon black to the ion-conductive elastomers as required in claim 3.

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (571) 272-1319. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark Kopec
Primary Examiner
Art Unit 1751

MK
January 22, 2006